

## REMARKS

In the Office Action mailed September 3, 1998, the Examiner requested an abstract of the disclosure. In addition, the Examiner requested additional labeling of the previously submitted drawings, Figures 1 and 2. Moreover, the Examiner requested the status of the parent cases noted on page 1 of the application.

With regard to the claims, the Examiner rejected claims 1-8 under 35 U.S.C. §112, second paragraph. The Examiner also rejected claims 1-8 under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over the '281 patent to Nakahara et al, the '838 patent to Chikaraishi et al, the '854 patent to Higuchi et al, the '664 patent to Asakura et al, the '562 patent to Melvin et al, and the '707 patent to Yamagishi et al.

In this response, applicants present an abstract and amendments to the drawings and specification. In addition, amendments are presented to claim 1, which are believed to place all pending claims in condition for allowance. Claims 1-8, remain pending for the Examiner's consideration.

### A. Abstract, Drawings, and Specification

In accordance with the Examiner's request, applicants herewith present an abstract for entry in this application. No new matter is added by this abstract.

Previously filed Figures 1 and 2 have been amended and labeled in accordance with the Examiner's request to more clearly illustrate the present invention. The enclosed drawing sheet contains Figures 1 and 2 revised in accordance with the Examiner's request. No new matter is presented by these revisions.

In addition, applicants have amended the specification to note the status of the prior parent applications from which the present application claims priority. One of the parent applications, Serial No. 08/542,793 filed on October 13, 1995, has been allowed and is awaiting issue. As soon as applicants receive notification of the patent number, that information will be submitted in this application.

### B. Rejection Under §112, Second Paragraph Has Been Remedied

The Examiner rejected claims 1-8 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter

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regarded as the invention. Specifically, the Examiner asserted that certain recitations in the claims are not found in the specification. For example, in claim 1, line 5, the Examiner questioned where "1.147" is found in the specification.

Applicants have amended claim 1 and removed all such references. Accordingly, this ground of rejection has been remedied.

**C. Rejection under §102(b) Has Been Overcome**

Claims 1-8 were rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over U.S. Patent 5,002,281 to Nakahara et al; U.S. Patent 5,048,838 to Chikaraishi et al; U.S. Patent 5,704,854 to Higuchi et al; U.S. Patent 5,730,664 to Asakura et al; U.S. Patent 5,779,562 to Melvin et al; and U.S. Patent 5,782,707 to Yamagishi et al. In support of the rejection, the Examiner contended that:

[A]pplicants are claiming inherent features of the reference golf balls, each reference taken alone. Note, especially the patent to Nakahara et al ('281). Any possible distinctions over said golf balls are deemed obvious minor variants thereof, simply to provide comparative examples. The burden is on applicants to show that inherence is not involved.

The present application claims priority from a series of parent applications, the earliest of which having an effective filing date of June 1, 1993. This predates several of the noted patents as follows. The '707 patent to Yamagishi et al has an effective date significantly later than the effective date of the present application. Similarly, the '664 patent to Asakura et al has an effective date significantly later than the effective date of the present application. And, the '854 patent to Higuchi et al has an effective date that is significantly later than that of the present application. Accordingly, none of those patents is prior art to this application.

With regard to the '562 patent to Melvin et al, applicants respectively direct the Examiner's attention to the priority data for that patent. The Examiner will note that the '562 patent claims priority to the same parent application that forms the basis of priority in the present application. And, that claim of priority is through the same chain of cases as the priority claim made in this application. Accordingly, the '562 patent to Melvin et al. is not prior art to this application.

The '281 patent to Nakahara et al is distinguishable from the subject matter

claimed in the present application because Nakahura et al. disclose a golf ball in which the specific gravity of the shell layer (2) is greater than the specific gravity of the core (1), see col. 2, lines 9-10. This is entirely opposite from the recitation in independent claim 1 in the present application, that the specific gravity of the intermediate layer is lower than the specific gravity of the core. Furthermore, Nakahura et al. entirely fail to disclose the particular combination of physical properties of the golf ball recited in claim 1. And, there is absolutely no mention of the specific recitations in claims 2-7, all dependent from independent claim 1.

Similarly, the '838 patent to Chikaraishi et al. is distinguishable from the subject matter claimed in the present application because Chikaraishi et al. disclose a golf ball utilizing a significantly smaller core than the ball recited in claim 1. As shown in the figure of the '838 patent, the core (1) of that ball is only 15 to 25 mm, col. 1, line 65. In contrast, the golf ball recited in claim 1 includes a core that has a diameter of "at least 29 mm." Furthermore, the layer (2) of the '838 patent has a hardness of 65 to 75 in JIS C hardness scale, see col. 2, lines 31-33. In contrast, claim 1 of the present application recites that the hardness of the intermediate layer is "at least 85 on JIS C...scale." And, Chikaraishi et al. entirely fail to disclose any type of relationship as to the hardness between the layer (2) and the cover (4). In contrast, independent claim 1 of the pending application recites that the cover is softer than the intermediate layer.

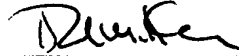
For at least these reasons, all pending claims are patentable over the cited patents.

**D. Conclusion**

In view of the foregoing, applicants respectfully submit that all pending claims, claims 1-8, are in condition for allowance.

Respectfully submitted,

FAY, SHARPE, BEALL, FAGAN,  
MINNICH & McKEE

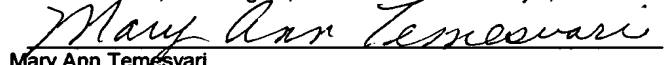


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**CERTIFICATE OF MAILING**

I hereby certify that this RESPONSE is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 on February 5, 1999.

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Mary Ann Temesvari

Approved  
LJM  
3-17-99

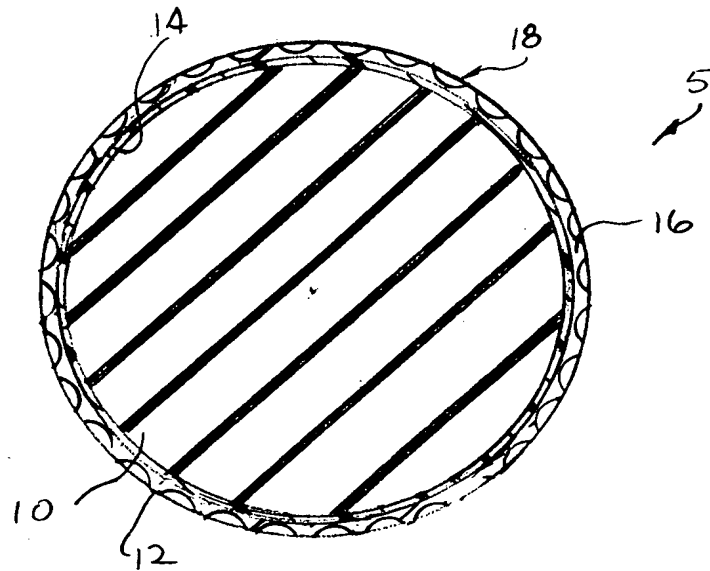


FIG. 1

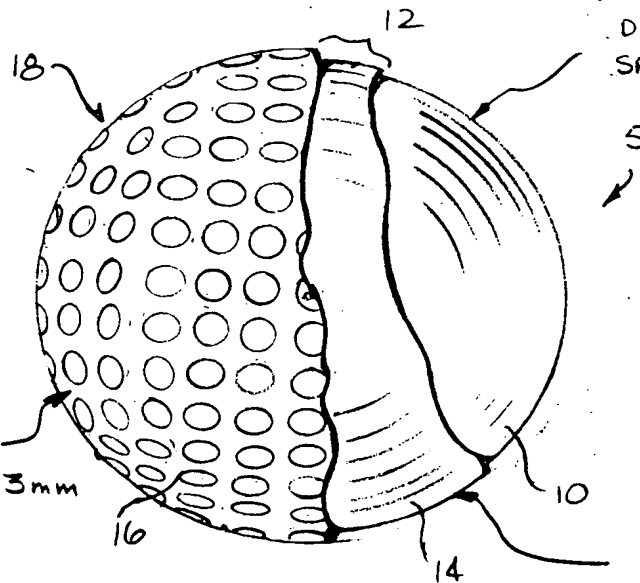


FIG. 2

COVER  
 $1\text{ mm} \leq \text{THICKNESS} \leq 3\text{ mm}$   
COVER SOFTER THAN  
INTERIOR LAYER

CORE  
DIAMETER  $\geq 29\text{ mm}$   
SPECIFIC GRAVITY  $< 1.4$

INTERIOR LAYER  
THICKNESS  $\geq 1\text{ mm}$   
SHORE C  $\geq 85$   
SPECIFIC GRAVITY OF  
INTERIOR LAYER  $<$   
SPECIFIC GRAVITY OF CORE